UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,969	01/21/2000	William J. Baer	STL000017US1	5170

46159   7590   07/16/2007
SUGHRUE MION PLLC
USPTO CUSTOMER NO WITH IBM/SVL
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER
NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
2176	

MAIL DATE	DELIVERY MODE
07/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/488,969	BAER ET AL.
	Examiner	Art Unit	
	Maikhanh Nguyen	2176	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 May 2007</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-15</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to RCE filed 05/03/2007 to the original application filed

01/21/2000.

Claims 1-15 are currently pending in this application. Claims 1, 6 and 11 have been

amended. Claims 1, 6 and 11 are independent claims.

Request Continuation for Examination

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR

1.17(e) has been timely paid, the finality of the previous Office action has been

withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/03/2007 has

been entered.

Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b),by another filed in the United States before the invention by the applicant for patent or (2)a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a)shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2)of such treaty in the English language; or " (Emphasis added.)

Claims 1-3, 6-8, and 11-13 remain rejected under 35 U.S.C. 102(e) as being anticipated

by **Mortimer et al.** (US Patent No. 6091930, filed 03/04/1997).

As to claims 1, 6, and 11:

Mortimer teaches a method, program storage device, and system for providing

prerequisite checking in a system for creating a content object *(e.g., customize and modify*

the well-accepted knowledge base of the professor CITbook 40 to generate a student

CITbook 50 adapted for the professor's class ... generate a customized presentation

sequence for his/her class in accordance with a desired syllabus), being one of a book

(e.g. The student CITbook 50), a document, a collection of images, a collection of

musical selections, a video and a multimedia object from a plurality of individual content

entities including content for the content object *(e.g., a particular type of data including*

text, images, illustrations, simulations, audio and video for inclusion into a professor

CITbook 50. For example, data relevant to the field of biomedical engineering and in

particular, relating to the comprehension and construction of neural prostheses is

collected from technical fields including electronics, electromagnetic fields, mechanics,

material science, neuroscience, electrochemistry, organ physiology and pathology, and

other biomedical engineering specialties) and stored in a data repository as a plurality of

individual file objects *(e.g., The student CITbook 50 ...its stored knowledge base; col. 7, lines 5-9)*, some of the content entities being prerequisites to others of the content entities, the method comprising the steps of:

- adding or removing a selected content entity to or from the content object *(e.g., subject matter, topic, and knowledge level and the data...manipulate portions of the primary knowledge base ... the data added or altered; see Abstract; col. 7, lines 1-37; col. 14, lines 37-50 and col.16, line 55-col. 17, line 18)*, wherein a prerequisite content entity is associated with another content entity and designated for inclusion in the content objects for which that other content entity is selected and placed *(e.g., the general purpose CITbook 30 is created based on an assembly of data entry modules 60. The data modules 60 each process a particular type of data including text, images, illustrations, simulations, audio and video for inclusion into a professor CITbook 50. For example, data relevant to the field of biomedical engineering and in particular, relating to the comprehension and construction of neural prostheses is collected from technical fields including electronics, electromagnetic fields, mechanics, material science, neuroscience, electrochemistry, organ physiology and pathology, and other biomedical engineering specialties ... determine which portions of the collected data are well-accepted among experts in the relevant field. The well-accepted data includes data which is believed to be "true" at the time of review and of course includes established proven theories and topics. The set of well-accepted data is*

considered the "truth" in the relevant field of study and forms a primary

knowledge base of the professor CITbook 40; col. 7, lines 39-62 /a map module

130 allows professor CITbook 40 and student CITbook 50 creators, namely

professors and other experts, to define a preferred presentation route through the

knowledge base by creating data links 132 between topics or objects and also

allows student CITbook 50 readers, for example students, to create customized

presentation routes which become personalized sequences. The links are created

in many ways such as by linking all similar key words 134, manually selecting

links 136, and linking objects based on a set of questions and answers 138; col.

11, line 61-col. 12, line 8 and col. 18, line 60-col. 19, line 28), and wherein the

associations between content entities and prerequisite content entities are stored

external of the individual file objects *(e.g., The student CITbook 50 ...its stored*

knowledge base in the preferred or customized presentation sequence; col. 7,

lines 1-26) containing the content entities *(e.g., the student CITbook 50 ... which*

includes multimedia components for presenting various formats such as textual,

graphical, video/audio, and simulations; col. 14, lines 12-22);

- examining the stored associations between content entities and prerequisite

  content entities and determining if the selected content entity has any prerequisite

  content entities associated with that content entity *(e.g., determine which portions*

  of the collected data are well-accepted among experts in the relevant field. The

  well-accepted data includes data which is believed to be "true" at the time of

review and of course includes established proven theories and topics. The set of

well-accepted data is considered the "truth" in the relevant field of study and

forms a primary knowledge base of the professor CITbook 40. Preferably, a

separate professor CITbook 40 is generated for each selected scientific area or

subject matter; col. 7, lines 38-62; col. 8, lines 39-51; and col.13, lines 18-32);

- and if so, automatically *(e.g., dynamic; see Abstract)* adding or removing the

  associated prerequisite content entities to or from the content objects *(e.g., once*

  the professor CITbook 40 is generated from well-accepted knowledge determined

  by a community of experts, the same data-entry modules 60 used to receive,

  organize and categorize input data allow the professor to create a student version

  of the CITbook for distribution to students in his/her class ... by altering, adding

  and deleting any material existing in the primary knowledge base of the professor

  CITbook 40 as well as adding personal topics; col. 14, lines 37-50 and col. 16,

  line 55-col. 17, line 45).

As to claims 2, 7, and 12:

Mortimer teaches one or more of the prerequisites are conditional *(e.g., a set of rules and*

restrictions with which inputted information must comply; col. 15, line 52-col. 16, line

12).

As to claims 3, 8, and 13:

Mortimer teaches the conditions for applying a prerequisite are defined in one or more

rules *(e.g., a set of predefined data-entry rules 74 or specifications for the document-*

entry process. The rules include specifying a selected data format which the data must

comply with before it is accepted by the interactive system. The data-entry rules provide

for formatting, organizing, categorizing and integrating the inputted material into a

professor CITbook ... rules 74 also include categorization rules which determine the

category of each portion of entered text such as "Subject Matter," "Topic," "Chapter

Title," and "Education Level." Categorization is performed for example by searching for

key words or requesting the data-entry person to identify the material; col. 8, lines 18-

51).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the
examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions
covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37
CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35
U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-5, 9-10, and 14-15 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over **Mortimer et al.** in view of **Tabuchi** (U.S. 6,606,633 – filed 09/1999).

As to claims 4, 9 and 14:

Tabuchi teaches in the case of more than one of the rules pertaining to the same

prerequisite, further comprising the step of reducing the rule set if possible into a smaller

set of rules *(col. 4, lines 4-60, col. 10, line 59-col. 11, line 36 & see fig.5 and the*

associated text).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify Mortimer with Tabuchi because it would have provided

the capability for checking a possibility/impossibility of relating of a data object with

reference to the structuring rule table, and the compound document object, when newly

relating to other object, inquires of the rule searching means whether relating of the

objects in a desired relation is possible or not.

As to claims 5, 10 and 15:

Tabuchi teaches the step of rewriting any negative rules as positive rules *(e.g., whether a*

structuring rule is being used in a compound document object or can not be recognized

... when the number of references of the designated structuring rule is not 0, the

structuring rule in question will not be deleted; col.11, lines 23-37).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify Mortimer with Tabuchi because it would have provided

the capability for checking a possibility/impossibility of relating of a data object with

reference to the structuring rule table, and the compound document object, when newly

relating to other object, inquires of the rule searching means whether relating of the

objects in a desired relation is possible or not.

Response to Arguments

5.   Applicant's arguments filed 05/03/2007 have been fully considered but they are not

persuasive.

Applicant argues that Mortimer does not teach *examining the stored associations between*

content entities and prerequisite content entities and determining if the selected content

entity has any prerequisite content entities associated with that content entity and adding

or removing the associated prerequisite content entities to or from the content object

[Remarks, page 9].

In response, Mortimer teaches examining the stored associations between content entities

and prerequisite content entities and determining if the selected content entity has any

prerequisite content entities associated with that content entity *(e.g., determine which*

portions of the collected data are well-accepted among experts in the relevant field. The

well-accepted data includes data which is believed to be "true" at the time of review and

of course includes established proven theories and topics. The set of well-accepted data

is considered the "truth" in the relevant field of study and forms a primary knowledge

base of the professor CITbook 40. Preferably, a separate professor CITbook 40 is

generated for each selected scientific area or subject matter; col. 7, lines 38-62; col. 8,

lines 39-51; and col.13, lines 18-32); and adding or removing the associated prerequisite

content entities to or from the content object *(e.g., once the professor CITbook 40 is*

generated from well-accepted knowledge determined by a community of experts, the same

data-entry modules 60 used to receive, organize and categorize input data allow the

professor to create a student version of the CITbook for distribution to students in his/her

class ... by altering, adding and deleting any material existing in the primary knowledge

base of the professor CITbook 40 as well as adding personal topics; col. 14, lines 37-50

and col. 16, line 55-col. 17, line 45).

As to dependent claims 2-5, 7-10, and 12-15, the arguments are not persuasive for reason

as discussed above with regards to independent claims 1, 6 and 11.

Conclusion

5.   The prior art made of record, listed on PTO 892 provided to Applicant is considered to

have relevancy to the claimed invention. Applicant should review each identified

reference carefully before responding to this office action to properly advance the case in

light of the prior art.

Contact information

6.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can

normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the

examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached

at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is

571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be

obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner for patents

P.O. Box 1450

Alexandria, VA 22313-1450

MN

WILLIAM BASHORE
PRIMARY EXAMINER